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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,975	04/14/2004	William Berson	BER-002	7527
1473	7590	09/22/2004	EXAMINER CARTER, MONICA SMITH	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/824,975

Applicant(s)

BERSON, WILLIAM

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is not clear to the examiner what is meant by the recitation "derived from a portion of a product".

In claim 26, line 7, "the temperature" lacks proper antecedent basis.

### ***Claim Objections***

3. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 claims the indicium being applied to the first side of the substrate, which has already been claimed in independent claim 1 upon which claim 2 depends.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-16 and 18-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams (5,653,844).

Abrams discloses multi-layered foil laminate (30) comprising a substrate (50) having a first side (52- lower surface) and a second side (upper surface) (as seen in figure 5), indicium (printing) being located on the first side of the substrate (as seen in figure 5); a thermally conductive layer (54) located on the first side of the substrate; and a background layer located on the first side of the substrate (see column 5, lines 17-35).

Regarding claim 2, see the above rejections to claim 1.

Regarding claims 3-6, the claimed processes ("substrate is derived from a portion of a product to which said label is applied", "said substrate is applied individually to a product", "said thermally conductive layer is applied individually to a product", "said background layer is applied individually to a product") do not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 7 and 8, Abrams disclose the claimed invention except for indicia printed on the lower surface of the substrate being any "suitable indicia" (see col. 5, lines 17-26). Inherently, this would include information-encoding indicium and human readable characters.

Regarding claims 9 and 10, set forth the intended use of the label. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 12 and 13, the indicium is applied on top of the background layer and has substantially similar optical properties (see column 5, lines 17-35).

Regarding claim 14, the label further comprising an adhesive layer (58) superposed on the substrate.

Regarding claims 15, 16 and 18, the label is made from a paper, plastic or metallic material (see column 5, lines 17-19 and lines 45-59).

Regarding claims 19-21, the thermally conductive layer is made from a transparent metallic foil/ink (see column 5, lines 17-59).

Regarding claim 22, the thermally conductive layer is applied on top of the indicium (as seen in figure 5).

Regarding claim 23, see the above rejections to claim 1.

Regarding claim 24, see the above rejections to claim 13.

Regarding claim 25, the optical properties of the indicium are substantially similar to the optical properties of the thermally conductive layer (see column 5, lines 17-59).

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Regarding claim 26, see the above rejections to claim 1.

Regarding claims 27 and 28, the label is, inherently, made from a material with high thermal conductivity.

Regarding claim 29, see the above rejections to claim 1.

Regarding claims 30 and 31, the method for producing a label that is adapted to receive an indicium having varying spectral emissivity values as set forth in the above rejections.

Regarding claim 32, Abrams discloses using a portion of a product that is to receive the label as the substrate (see column 4, lines 38-53).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams.

Regarding claim 17, Abrams discloses the claimed invention except for the label being made from tyvec. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the label,

since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 33 and 34, it would have been obvious to apply the thermally conductive layer to the first side of the substrate either substantially simultaneously or not substantially simultaneously, since applicant has failed to disclose that the sequential order of applying the thermally conductive layer to the substrate is critical to the invention.

#### ***Allowable Subject Matter***

8. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

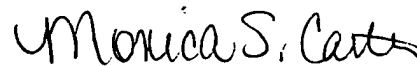
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose label assemblies.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 17, 2004

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**